

R E M A R K S

This is in response to the Office Action that was mailed on November 19, 2003. Applicants gratefully acknowledge the Examiner's indication that claims 4 and 12 are allowable in substance. Claim 1 is amended to incorporate the recitation of former claim 4. Claims 3 and 4 are cancelled without prejudice. The dependencies of claims 5 and 6 are adjusted. Claim 9 is amended to incorporate the recitation of former claim 12. Claims 11 and 12 are cancelled without prejudice. The dependencies of claims 13 and 14 are adjusted. Claim 17 is amended to recite the feature of former claim 18. Claims 19 and 24 are amended in accordance with disclosure throughout the specification to recite that the oxidizing agent comprises a fuel, an oxidizing agent, and a slug-forming agent. In addition, the language of certain claims has been made more precise in order to more particularly point out and distinctly claim the invention. No new matter has been introduced by this Amendment. Claims 1, 2, 5-10, and 13-24 are in the application.

It is noted that the Office Action Summary listing alleges that the Office Action is responsive to a communication filed on 15 January 2003 and that proposed drawing corrections filed on 15 January 2003 should be followed by corrected drawings. It is respectfully submitted that the Office Action is actually responsive to a communication filed on 14 August 2003, and that

corrected drawings were filed on 11 July 2003. The Examiner is respectfully requested to acknowledge receipt of the corrected drawings.

Claims 1-3, 5-11, 13-17, and 19-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,351,988 (Bishop) in view of US 5,711,546 (Hamilton) and US 6,474,684 (Ludwig). This rejection is respectfully traversed.

Claims 1, 2, 5-8, and 20-23 now recite a feature of former claim 4, and are clearly not subject to this rejection for the same reason that claim 4 was not subject to this ground of rejection. Claims 9, 10, and 13-16 now recite a feature of former claim 12, and are believed not to be subject to this rejection, for the same reason that claim 12 was indicated to be allowable. Likewise, claims 19 and 24 not recite the feature which characterizes the claims indicated to be allowable by the Examiner, so that claims 19 and 24 are likewise believed to be patentable over Bishop in view of Hamilton and Ludwig.

Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bishop in view of Hamilton and US 6,177,028 (Kanda). To the extent that it might be applied to claim 17 in its present form, this rejection is respectfully traversed.

Bishop shows a gas generator that includes a gas generating agent 320 and an opening 308 closed by a burst disk 310. Since the opening 308 is located at the end of the axis of the housing 302, Bishop fails to teach or suggest the present invention. Hamilton shows in Figure 5 a first housing 216 provided with propellant grains 258. Hamilton's first housing 216 includes such openings as a bleed port 262 on a peripheral wall thereof and also an afterburner nozzle 274. In the Kanda reference, the gas discharging ports 26 or 28 are formed in the side surface, but Kanda does not teach or suggest extending them along the longitudinally axial direction. Moreover, the Kanda reference, which is directed to pyroinflators, is not properly combined with the Hamilton and Bishop references.

In fact, the number of different references combined by the Examiner to reject this one claim – Bishop, Hamilton, and Kanda – raises the question of whether the rejection as stated involves improper hindsight. The rigorous burden placed upon an Examiner for establishing a *prima facie* case of obviousness was reviewed by the United States Court of Appeals for the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, (Fed. Cir. 2002). In *Lee*, the court observed:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

... *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

It is respectfully urged that the Examiner has not met his burden of proof with respect to the rejection of record.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 18 – now claim 17 – or to point out in detail how a person of ordinary skill in the art would be motivated to combine the

disclosures of Bishop, Hamilton, and Kanda to construct a hybrid inflator for vehicle air bags that includes all of the following elements (A)-(J):

(A) an inflator housing containing a pressurized medium having a gas exit opening closed by a rupturable disk, (B) the pressurized medium containing an inert gas and no oxygen;

a gas generating agent comprising (C) a fuel, (D) an oxidizing agent, and (E) a slug-forming agent;

(F) a gas generator installed in and attached to the inflator housing, (G) said gas generator having a gas generating chamber that contains the gas generating agent and (H) having a plurality of ports formed only along a longitudinal axis of the gas generator in a circumferential wall thereof extending in the longitudinal direction; and

(I) an ignition means chamber connected to the gas generator and (J) including an ignition unit adapted to ignite the gas generating agent.

Conclusion

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of the pending claims in the present application are respectfully requested.

Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

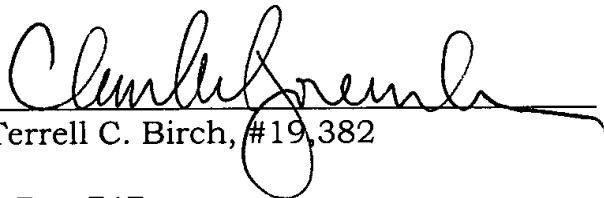
Appl. No. 09/857,891

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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